

Serial No. : 10/686,895
Filed : October 16, 2003

REMARKS

In the office action, the examiner objected to the specification on the ground that the abstract of the disclosure on has the newly added feature "if a point of interest is located within a large structure" is a new matter. The examiner stated that "if" is a conditional statement that requires the fulfillment of certain conditions. Based on the same reason, the examiner rejected Claims 1-18 under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The applicant is disappointed at the examiner's repeated incorrect assertions regarding the new matter issue. The newly added feature is supported by the description in the paragraph from page 15, line 16 to page 15, line 31, which reads as follows:

In response, the navigation system retrieves the map data including POI information from the map data storage 21 which is stored in the map information memory 24. The POI display control unit 40 checks the map data from the map memory 24 to see whether the retrieved POI is located within a large structure. As described later with reference to Figures 10 and 11, information for determining whether the retrieved POI is located within a large structure or not is available from the map data stored in the existing map data storage. If there is a POI that is located within a large structure, the POI display control unit 40 detects the information on the specific type of the large structure. Then the POI display control unit 40 retrieves the icon data that match with the type of large structure from the buffer memory 39. Thus, for the POI located in the large structure, the icon data is attached to the POI name.

Therefore, the objection to the specification and the rejection of Claims 1-18 under 35 U.S.C. 112, first paragraph is clearly erroneous.

Serial No. : 10/686,895
Filed : October 16, 2003

In the previous office action, the examiner objected to the abstract of the disclosure on the ground that the newly added feature "when a particular point of interest is located within a large structure" is a new matter. The examiner stated that "when" indicates a time when the list shall include the icon representing the structure.

Within the context of the present invention, the word "when" is used for indicating situations or circumstances, not a time. English dictionary Cobuild says that "you use **when** to introduce a clause where you mention the circumstances under which the event in the main clause happened or will happen". A person skilled in the art can easily understand from the original disclosure of the instant application that the point of the invention is directed to the situation where specified POIs such as restaurants, shops, etc. are located within a large structure such as an airport, stadium, etc. Thus, within the context of the present invention, both "if" and "when" express the situation or condition whether or not the specified POIs are located within the large structure. Thus, the objection by the examiner is incorrect.

As discussed in the previous response to the office action with respect to the amendment in the claims, there is the same or substantially the same expression as that of the above in the specification. As discussed in the previous response to the office action both of the words "when" and "if" are used in the original disclosure for expressing the same meaning. Further, the examiner

Serial No. : 10/686,895
Filed : October 16, 2003

should know that even if the same language is not found in the original description, mere rephrasing does not constitute new matter (MPEP 2163.07). In this response to the office action, the applicant has amended back to use the word "when" because "when" is used in the original disclosure more often than "if".

In the previous response to the office action, the applicant has already showed the support of the newly added feature. Here, the applicant reiterates the supports again in consideration of the limited capability of the examiner. In the previous office action, the examiner rejected Claims 1-18 under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. It is stated that the amended feature of "when a particular point of interest is located within a large structure, the list includes the icon representing the type of the large structure *adjacent to the name of the particular point of interest*" is not supported by the original disclosure.

The first half of the above sentence "when a particular POI is located within the large structure" is disclosed, for example, in the paragraph from page 8, line 7 to page 8, line 20, which reads as follows:

According to the present invention, navigation system is capable of informing the user about the existence of a large structure when a particular POI is located within the large structure. Thus, the user is able to decide not to go to that particular POI because it is located within the large structure, or alternatively, go to that particular POI because he can also use the large structure such as do shopping or use a rest room, etc. The navigation system can effectively minimize the information provided to the user to prevent distraction

Serial No. : 10/686,895
Filed : October 16, 2003

of the user's attention by providing information with a pictographic icon. Moreover, the present invention can be readily implemented to a conventional navigation system where the space for a display is limited because the icon does not take much space on the display.

The same recitation as underlined is also found in the paragraph from page 20, line 32 to page 21, line 12. Thus, the recitation "when a point of interest is located within a large structure" is supported by the original disclosure. It should also be noted that the word "when" used in this invention means a "situation" rather than a "time".

With respect to the second half "the list includes the icon representing the type of the large structure adjacent to the name of the particular point of interest" of the amended feature, the original disclosure includes the paragraph from 16, line 33 to page 17, line 6, which reads as follows:

An example of display screen implementing the present invention is shown in Figure 9A which is a more detailed view of Figure 7D. In Figure 9A, the display of the navigation system includes a superimposed icon next to the POI name when the POI is located within a large structure. For example, a shopping mall icon 95 shown in more detail in Figure 8 is provided next to "Burger King" indicating that "Burger King" is located within the shopping mall.

The word "adjacent" in the amended feature means that --two things are next to each other-- (Collins, "Cobuild English Dictionary"). Since the original disclosure shows that "the list includes the icon representing the type of the large structure next to the name of the particular point of interest". As noted above, the word "adjacent" and the word "next to" have the same meaning,

Serial No. : 10/686,895
Filed : October 16, 2003

and --mere rephrasing does not constitute new matter-- (MPEP 2163.07), the amended feature of the claims dose not introduce any new matter. Nonetheless, in the previous response, the applicant has change the word "adjacent" to "next to".

In the office action dated June 29, 2006, however, the examiner contends that there is no support or suggestion in the original disclosure for the term "next to". As discussed above, the term "next to" is supported by the original description, thus, the amendment is not a new matter.

In the office action, the examiner rejected Claims 1-18 under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter of the invention. It is stated that the terms "large", "type" and "next to" are not clear. The basic rule is that acceptability of the claim language depends on whether one of ordinary skill in the art would understand what is claimed, in light of the specification. The fact that claim language includes relative terms does not automatically render the claim indefinite. MPEP 2173.05 (b) .

In this particular invention, the term "large structure" helps to understand the invention because the point of the invention is directed to the situation where specified POIs such as restaurants, shops, etc. are located within a large structure such as an airport, stadium, etc. Because of the particular character of the present invention, the term "large structure" provides the reader

Serial No. : 10/686,895
Filed : October 16, 2003

intuitive understanding of the invention. The term "type" also helps to clarify the invention because the icon used in the present invention is to show the type, such as airport, stadium, office building, etc. of the large structure. As discussed above, the term "next to" is clearly supported by the description and is shown in Figures 9A and 9B in which the icon representing the type of the large structure is displayed next to the name of the specified point of interest. Thus, the issue of how close or separated indicated by the examiner will not arise.

In the office action, the examiner rejected Claims 1-18 under 35 U.S.C. 102(b) as being anticipated by Miyaki (U.S. Patent Application Publication No. 2002/0130906). As recited in Claims 1, 7 and 13, the essential features of the present invention reside in the fact that (1) the navigation system displays a list of names of points of interest specified by the user, and (2) if a point of interest is located within a large structure, the list includes the icon representing the type of the large structure next to the name of the particular point of interest. The cited Miyaki reference does not show or suggest these essential features of the present invention as discussed below.

The cited Miyaki reference is directed to a point of interest icon display method for displaying a point of interest icon on a map image on the display screen. It should be noted that the present invention is not directed to the point of interest icon display method. Icons of points of interest are not displayed on

Serial No. : 10/686,895
Filed : October 16, 2003

the navigation system, but only the icon of the large structure is displayed only if a point of interest is located within the large structure. More specifically, in the present invention, the points of interest are displayed by a list of names of the points of interest as noted by the feature (1) above. None of the drawings of the cited Miyaki reference show a list of names of points of interest. Therefore, the cited Miyaki reference does not show or suggest the essential feature (1) of the present invention.

With respect to the large structure, Miyaki indicated the problem involved in the conventional technology in displaying an icon of a large structure (large premise) in paragraph 4 which reads as follows:

[0004] The navigation apparatus displays POI (facilities) having large premises, such as parks, hospitals, and factories, using polygons, as shown in FIG. 14, and displays, within the polygon, a mark (POI icon) indicating the category of the POI along the road. When this POI icon is pointed to by a cursor and the enter key is pressed, the navigation apparatus displays detailed information about the selected POI. However, since the POI icon is displayed at an end of the polygon, it is difficult to see the POI icon, and moreover, when the POI icon is at an end of a polygon, it is difficult to point to the POI icon using the cursor, and there is a problem in that another nearby POI icon might be selected erroneously. (underline added)

It is apparent from the citation above, the problem to be solved by the technology of Miyaki is to display the icon of the large premise in a manner more easily seen by the user because it is difficult to see the POI icon since the POI icon is displayed at an end of the polygon. To solve this problem, the invention disclosed by the cited Miyaki reference displays the topological

Serial No. : 10/686,895
Filed : October 16, 2003

shape of the large premise (large POI) on the map and displays the icon of the large premise at the center of the topological shape. This solution of the problem by the cited Miyaki reference is described in paragraph 8, which reads as follows:

[0008] According to the present invention, the second object can be achieved by a POI icon display method comprising the steps of: (1) displaying a POI on a map by using a polygon; and (2) displaying the POI icon which is present within the POI polygon in the central portion of the polygon. (underline added)

In the present invention, however, as stated in the feature (2) above, if a point of interest is located within a large structure, the list includes the icon representing the type of the large structure next to the name of such a point of interest. In other words, the display method of the present invention will not display the map or the shape of the large structure but displays the list of names of the points of interest. If a point of interest in the list is located within a large structure, the icon of the large structure is displayed adjacent to the name of the point of interest. Since the map image or the topological shape of the large structure is not displayed in the present invention, it never occurs that the icon of the large structure is displayed at the center of the large structure. Therefore, the cited Miyaki reference does not show or suggest the essential feature (2) of the present invention.

Since none of the essential features of the present invention are shown or suggested by the cited Miyaki reference, the applicant

Serial No. : 10/686,895
Filed : October 16, 2003

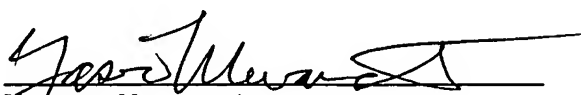
believes that the rejection under 35 U.S.C. 102(b) is no longer applicable to the present invention.

Under the circumstances, the applicant believes that the present application is in the condition for allowance, and the applicant respectfully requests that the present application be allowed and passed to issue.

Respectfully submitted,

MURAMATSU & ASSOCIATES

Dated: 11/29/2006

By: 
Yasuo Muramatsu
Registration No. 38,684
114 Pacifica, Suite 310
Irvine, CA 92618
(949) 753-1127

AMD-AP36.004
112806